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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/008,271	10/05/2006	6964688		7653

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EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



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(THIRD PARTY REQUESTER'S CORRESPONDENCE ADDRESS)

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**EX PARTE REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/008,271.

PATENT NO. 6964688.

ART UNIT 3993.

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

<b>Order Granting / Denying Request For Ex Parte Reexamination</b>	Control No.	Patent Under Reexamination	
	90/008,271	6964688	
	Examiner	Art Unit	
	David O. Reip	3993	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 05 October 2006 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) ☐ PTO-892, b) ☒ PTO/SB/08, c) ☐ Other: \_\_\_\_\_

1. ☒ The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): TWO MONTHS from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): TWO MONTHS from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

2. ☐ The request for *ex parte* reexamination is DENIED.

This decision is not appealable (35 U.S.C. 303(c)). Requester may seek review by petition to the Commissioner under 37 CFR 1.181 within ONE MONTH from the mailing date of this communication (37 CFR 1.515(c)). **EXTENSION OF TIME TO FILE SUCH A PETITION UNDER 37 CFR 1.181 ARE AVAILABLE ONLY BY PETITION TO SUSPEND OR WAIVE THE REGULATIONS UNDER 37 CFR 1.183.**

In due course, a refund under 37 CFR 1.26 ( c ) will be made to requester:

- a) ☐ by Treasury check or,  
b) ☐ by credit to Deposit Account No. \_\_\_\_\_, or  
c) ☐ by credit to a credit card account, unless otherwise notified (35 U.S.C. 303(c)).

cc:Requester ( if third party requester )

### ***DECISION ON REQUEST FOR REEXAMINATION***

A substantial new question of patentability affecting claims 1, 2, 8, 10-13, 16-19, 23, 26, 27, 50, 51, 54-56, 60, 62-66 and 69 of United States Patent Number 6,964,688 to Kania (herein after "the '688 patent") is raised by the request for *ex parte* reexamination.

### ***Service of Papers***

After filing of a request for *ex parte* reexamination by a third party requester, any document filed by either the patent owner or the third party requester must be served on the other party (or parties where two or more third party requester proceedings are merged) in the reexamination proceeding in the manner provided in 37 CFR 1.248. The document must reflect service or the document may be refused consideration by the Office. See 37 CFR 1.550(f).

### ***Waiver of Right to File Patent Owner Statement***

In a reexamination proceeding, Patent Owner may waive the right under 37 CFR 1.530 to file a Patent Owner Statement. The document needs to contain a statement that Patent Owner waives the right under 37 CFR 1.530 to file a Patent Owner Statement and proof of service in the manner provided by 37 CFR 1.248. If the request for reexamination was made by a third party requester, see 37 CFR 1.550(f). The Patent owner may consider using the following statement in a document waiving the right to file a Patent Owner Statement:

*Patent Owner waives the right under 37 CFR 1.530 to file a Patent Owner Statement.*

### ***Extensions of Time***

Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that *ex parte* reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extensions of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

### ***Amendment in Reexamination Proceedings***

Patent Owner is notified that any proposed amendment to the specification and/or claims in this reexamination proceeding must comply with 37 CFR 1.530(d)-(j), must be formally presented pursuant to 37 CFR 1.52(a) and (b), and must contain any fees required by 37 CFR 1.20(c).

### ***Notification of Concurrent Proceedings***

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving the '688 patent throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise

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the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

The references relied upon in the request are as follows:

1. *O&P Business News* dated September 1, 1994 (Advertisement of Silipos, p. 9)(hereinafter, the "Sep 1994 O&P Publication")
2. *O&P Business News* dated October 1, 1994 (Advertisement of Silipos)(hereinafter, the "Oct 1994 O &P Publication")
3. *O&P Business News* dated January 1, 1995 (Advertisement of Silipos, p. 16 and p. 22, and Advertisement of Cascade Orthopedic Supply, Inc. of Iceross <sup>TM</sup>, p. 23)(hereinafter, the "January 1995 O&P Publication")
4. PEL Supply Company 1994 Prosthetic Catalog (hereinafter, the "1994 PEL Publication")
5. U.S. Pat. No. 5,633,268 to Chen (hereinafter, "Chen")

The request indicates that the requester considers:

(1) Independent claims 1 and 2 and dependent claims 8, 10-12, 17-19, 23, 26, 27, 50, 54-56, 60 and 64-66 are unpatentable over the Jan 1995 O&P Publication taken with Chen, the 1994 PEL Publication, and the Sep 1994 O&P Publication.

(2) Dependent claims 13, 16, 51, 62, 63 and 69 are unpatentable over the Jan 1995 O&P Publication taken with the Sep 1994 O&P Publication, Chen, the 1994 PEL Publication, and the Oct 1994 O&P Publication.

### ***The O&P Publications***

The O&P Publications are new teachings, not previously considered nor addressed in the prior examination of the patent or a final holding of invalidity by the Federal Courts.

The O&P Publications raise an SNQ with respect to claims 1, 2, 8, 10-13, 16-19, 23, 26, 27, 50, 51, 54-56, 60, 62-66 and 69.

Independent claim 1 requires, *inter alia*, "A tube-shaped covering for enclosing an amputation stump, said covering comprising fabric coated on only the inside thereof with polymeric material...said covering configured to have an open end for introduction of said stump and a closed end opposite said open end." At least the Sep 1994 O&P Publication teaches the Silosheath tube-shaped covering comprising a fabric coated on only the inside thereof with a polymeric material (seen in the circular figure, which shows fabric, a layer of polymer gel, and then skin). During the prosecution of the application that became the '688 patent, at least three publications disclosing the Silosheath were made of record. However, none of the publications clearly taught the fabric of the sheath being coated on only the inside thereof with the polymer gel. Thus, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claim 1 was patentable. Accordingly, the O&P Publications raise an SNQ as to independent claim 1 and claims that depend therefrom, which has not been decided in a previous examination of the '688 patent.

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Independent claim 2 requires, *inter alia*, "A tube-shaped covering for enclosing an amputation stump, said covering comprising fabric coated on the inside thereof with polymeric material...said covering configured to have an open end for introduction of said stump and a closed end opposite said open end." As discussed above, the Sep 1994 O&P Publication teaches the Silosheath tube-shaped covering comprising a fabric coated on the inside thereof with a polymeric material. Further, p. 22 of the Jan 1995 O&P Publication teaches the Soft Socket Gel Liner comprising polymer gel sandwiched between layers of fabric. During the prosecution of the application that became the '688 patent, at least three publications disclosing the Silosheath were made of record. However, none of the publications clearly taught the fabric of the sheath being coated on the inside thereof with the polymer gel. Thus, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claim 2 was patentable. Accordingly, the O&P Publications raise an SNQ as to independent claim 2 and claims that depend therefrom, which has not been decided in a previous examination of the '688 patent.

### ***The PEL Publication***

The PEL publication is a new teaching, not previously considered nor addressed in the prior examination of the '688 patent or a final holding of invalidity by the Federal Courts.

The PEL publication raises an SNQ with respect to claims 1, 2, 8, 10-13, 16-19, 23, 26, 27, 50, 51, 54-56, 60, 62-66 and 69.



Independent claims 1 and 2 require, *inter alia*, "A tube-shaped covering for enclosing an amputation stump, said covering comprising fabric coated on...the inside thereof with polymeric material capable of forming an air-tight seal with a limb of a wearer." The PEL publication teaches, on p. 170, a "Durasleeve" tube-shaped covering comprising an airtight seal, and teaches on p. 192 the gel-lined Silosheath discussed above. There is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claim 1 was patentable. Accordingly, the PEL publication, especially taken together with the teachings of the O&P Publications, raises an SNQ as to independent claims 1 and 2 and claims that depend therefrom, which has not been decided in a previous examination of the '688 patent.

***U.S. Patent No. 5,633,286 to Chen***

The Chen reference is considered "old art" since it was previously considered in the prior examination of the '688 patent.

Chen raises an SNQ with respect to claims 1, 2, 8, 10-13, 16-19, 23, 26, 27, 50, 51, 54-56, 60, 62-66 and 69.

Independent claims 1 and 2 require, *inter alia*, "A tube-shaped covering for enclosing an amputation stump, said covering comprising fabric coated on...the inside thereof with polymeric material capable of forming an air-tight seal with a limb of a wearer."

Chen teaches gels comprising block copolymers in combination with mineral oil plasticizer to form a gel for use with orthopedic and cushioning applications, such gel being similar to the polymer gel used in the Silosheath discussed above. Further, it appears the Chen gels are inherently tacky, since in col. 8, lines 51-54 it is taught that "The gels of the composites of the invention may be made non-adhering, non-sticking, non-tacky by incorporating an advantage amount of stearic acid...and metal stearates." Therefore, consideration as to whether or not a tacky gel would inherently form an airtight seal with a limb needs to be made. Thus, there is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not these claims are patentable. Accordingly, Chen, especially when taken together with the additional teachings of the O&P Publications and the PEL Publication, raises an SNQ as to independent claims 1 and 2 and claims that depend therefrom, which has not been decided in a previous examination of the '688 patent.

### ***Conclusion***

For the reasons given above, each of the references cited by the requester raises a substantial new question of patentability with respect to the subject patent. Since requester did not request reexamination of claims 3-7, 9, 14, 15, 20-22, 24, 25, 28-49, 52, 53, 57-59, 61, 67, 68, 70 and 71 and did not assert the existence of a substantial new question of patentability (SNQ) for such claims (see 35 U.S.C. § 311(b)(2); see also 37 CFR 1.915b and 1.923), such claims will not be reexamined. This matter was squarely addressed in *Sony Computer Entertainment America Inc., et al. v.*

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*Jon W. Dudas*, Civil Action No. 1:05CV1447 (E.D.Va. May 22, 2006), Slip Copy, 2006 WL 1472462. The District Court upheld the Office's discretion to not reexamine claims in an *inter partes* reexamination proceeding other than those claims for which reexamination had specifically been requested. The Court stated:

"To be sure, a party may seek, and the PTO may grant, ... review of each and every claim of a patent. Moreover, while the PTO in its discretion may review claims for which ... review was not requested, nothing in the statute compels it to do so. To ensure that the PTO considers a claim for ... review, § 311(b)(2) requires that the party seeking reexamination demonstrate why the PTO should reexamine each and every claim for which it seeks review. Here, it is undisputed that **Sony** did not seek review of every claim under the '213 and '333 patents. Accordingly, **Sony** cannot now claim that the PTO wrongly failed to reexamine claims for which **Sony** never requested review, and its argument that AIPA compels a contrary result is unpersuasive."

Accordingly, only claims 1, 2, 8, 10-13, 16-19, 23, 26, 27, 50, 51, 54-56, 60, 62-66 and 69 of the subject patent will be reexamined.

**All correspondence relating to this *ex parte* reexamination proceeding should be directed as follows:**

**By U.S. Postal Service Mail to:**

Mail Stop *Ex Parte* Reexam  
ATTN: Central Reexamination Unit  
Commissioner for Patents

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Central Reexamination Unit

By hand to: Customer Service Window  
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Any inquiry concerning this communication or earlier communications from the Reexamination Legal Advisor or Examiner, or as to the status of this proceeding, should be directed to the Central Reexamination Unit at telephone number (571) 272-7705.



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Conferee 

Conferee 